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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,553

Applicant(s)

SANDLIN ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16, 17, 19, 20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-14, 16-17, 19-20, and 22-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 13, 14, 16, 17, 19, 20, 22, and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A. The above recited claims depend from claims which are directed to a method. The above claims are directed to paints or mixtures. It is not seen that the above claims further limit the method claims from which they depend therefore as required by the above cited rule.

B. It is unclear how the limitations of claims 22-23 further limit claims 1 and 7 in that it is not seen that the choice of any scenting agent cannot be somehow said to be a function of some aspect of room information.

2. Claims 1-11, 13-14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what the distinction, if any, is between the instantly claimed binder and vehicle of the instant claims. It would seem that the function of the vehicle, as described in the instant specification, would be done by the binder or perhaps the solvent mixed with binder. The instant specification does not adequately describe the distinction between these components. It is therefore unclear what is required in addition to the solvent and binder of the claim to serve as the required "vehicle". The term "vehicle" does not appear to be used in its ordinary sense as defined at page 6 of the instant specification since the binder would appear to perform this function. The prior cited Walker patent is cited as evidence in this regard, particularly the abstract; column 1, lines 15-16 and 43-46; and column 3, lines 45-52 which appears to

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encompass the binder as the vehicle because the binder will adhere the pigment to the substrate.

Clarification seems needed.

B. It is unclear what "mixture" is meant by the instant claims 16, 17, 19, 20, and 22-24. There is no antecedent basis for "mixture" in the claims from which these claims depend and any combination of ingredients of the independent claims can be combined to give a "mixture". It is unclear what is intended by "mixture" therefore, i.e. which "mixture" of the prior claims is being claimed is unclear.

C. It is unclear how one is to meet the requirements of the instant claims 22-23 and what information must be imparted about the room per se. It is unclear how the limitations of claims 22-23 further limit claims 1 and 7 in that it is not seen that the choice of any scenting agent cannot be somehow said to be a function of some aspect of room information.

D. The term "long-lasting" in claims 1 and 7 is a relative term which renders the claim indefinite. The term "long-lasting" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is therefore unclear what is intended by "long-lasting". It is unclear if this means a whole day, a week, a year, or longer.

3. Claims 1-5, 13, 16, 19, and 22-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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A. The instant claims require a binder and a vehicle. The function of the vehicle noted in the instant specification at page 6 would appear to be that of the binder. It is therefore not clear what compounds may constitute the vehicle other than the binder and the instant specification does not clarify this issue nor adequately describe what may be used as a vehicle specifically.

B. The instant claims 22-23 recite limitations which are not adequately described in the instant specification. It is unclear how one is to meet the requirements of the instant claims 22-23 and what information must be imparted about the room per se and these things are not adequately described in the instant specification.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1, 7, 10, 13, 14, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by the declarants'/applicants' declarations of 5/19/06 which states that they, in their capacity as painters hired to paint the public buildings, as stated in their declarations, which were then subsequently leased to the public according to the declaration of Beverly A. Rahe, painted the walls of the declared public buildings and in doing so gave their invention to the public because, as a matter of law, the paint became the property of the public building upon its application to the premises. Particular attention to paragraph 9 of the Oltman declaration has been given, which appears to be an admission that the instantly claimed inventions were used in public so as to create a statutory bar according to the above cited statute. It is noted that the declarants/applicants state that this was done in an experimenting capacity. However, the declarants/applicants state that they have no lab notes as evidence of such experimentation and the declarations provide no specifics of such experimentation beyond mixing the paint and applying it to the walls of the public building thereby putting the instantly claimed inventions in the public use. Furthermore, it is not clear to the examiner that the use of the instantly claimed inventions in the applicants' capacity of paid painters does not constitute an "on sale" bar. It would be expected that painters hired to paint a room would supply the paint in the examiner's experience. On painting the room and supplying the scented paint, the applicant's appeared to be acting within their paid status as painters for the property specified in their declarations. The applicant's state that they were paid to paint the premises as stated in e.g. paragraph 2 of the Oltman declaration. The subsequent recitations regarding the inventors not being paid for using the scented paint and using it in an experimental capacity are noted. This issue seems to straddle the situations which the examiner is familiar with regarding on sale and public use bars. It is the

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examiner's position that the "on sale" bar may be adequately overcome by the current declarations but the examiner is interested in any further evidence/caselaw the applicant's attorney may offer on this point. The issue is less clear regarding the "public use" aspect of 102(b). The examiner believes that further evidence of the experimentation occurring during the time preceding filing of the instant application in which a statutory bar may occur is needed to determine what experimentation was done during the statutory bar period and if such experimentation was sufficient to overcome said statutory bar. It is noted that the applicant's did not keep notebooks. However, the declarations currently submitted are scant on any details as to what was done other than the declaration states that the Arm & Hammer product was used. The contents of this product were not disclosed nor were the amounts thereof nor were the paint compositions nor any evidence of other experimental testing specified. Thus, the record is not sufficiently clear. Further evidence of secrecy agreements, when the room was leased, etc. might also be of value in the above determinations. The examiner notes MPEP 2133.03, particularly:

When the inventor or someone connected to the inventor puts the invention on display or sells it, there is a "public use" within the meaning of 35 U.S.C. 102(b) even though by its very nature an invention is completely hidden from view as part of a larger machine or article, if the invention is otherwise used in its natural and intended way and the larger machine or article is accessible to the public. *In re Blaisdell*, 242 F.2d 779, 783, 113 USPQ 289, 292 (CCPA 1957); *Hall v. Macneale*, 107 U.S. 90, 96-97 (1882); *Ex parte Kuklo*, 25 USPQ2d 1387, 1390 (Bd. Pat. App. & Inter. 1992) (Display of equipment including the structural features of the claimed invention to visitors of laboratory is public use even though public did not see inner workings of device. The

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person to whom the invention is publicly disclosed need not understand the significance and technical complexities of the invention.).

An Invention Is in Public Use If the Inventor Allows Another To Use the Invention Without Restriction or Obligation of Secrecy

“Public use” of a claimed invention under 35 U.S.C. 102(b) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor.” In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). The presence or absence of a confidentiality agreement is not itself determinative of the public use issue, but is one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986). See *Ex parte C*, 27 USPQ2d 1492, 1499 (Bd. Pat. App. & Inter. 1992) (Inventor sold inventive soybean seeds to growers who contracted and were paid to plant the seeds to increase stock for later sale. The commercial nature of the use of the seed coupled with the “on-sale” aspects of the contract and apparent lack of confidentiality requirements rose to the level of a “public use” bar.); *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881) (Public use found where inventor allowed another to use inventive corset insert, though hidden from view during use, because he did not impose an obligation of secrecy or restrictions on its use.).

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I would appear that the subsequent rental of the room of the applicant's declarations as declared by Beverly A. Rahe might meet the above situation.

C. Use by Independent Third Parties

Use by an Independent Third Party Is Public Use If It Sufficiently "Informs" the Public
of

the Invention or a Competitor Could Reasonably Ascertain the Invention

Any "nonsecret" use of an invention by someone unconnected to the inventor, such as someone who has independently made the invention, in the ordinary course of a business for trade or profit may be a "public use," *Bird Provision Co. v. Owens Country Sausage, Inc.*, 568 F.2d 369, 374-76, 197 USPQ 134, 138-40 (5th Cir. 1978).

Additionally, even a "secret" use by another inventor of a machine or process to make a product is "public" if the details of the machine or process are ascertainable by inspection or analysis of the product that is sold or publicly displayed. *Gillman v. Stern*, 114 F.2d 28, 46 USPQ 430 (2d Cir. 1940); *Dunlop Holdings, Ltd. v. Ram Golf Corp.*, 524 F.2d 33, 36-7, 188 USPQ 481, 483-484 (7th Cir. 1975). If the details of an inventive process are not ascertainable from the product sold or displayed and the third party has kept the invention as a trade secret then that use is not a public use and will not bar a patent issuing to someone unconnected to the user. *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 310 (Fed. Cir. 1983). However, a device qualifies as prior art if it places the claimed features in the public's possession before the critical date even if other unclaimed aspects of the device were not publicly available.

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Lockwood v. American Airlines, Inc., 41 USPQ2d 1961, 1964-65 (Fed. Cir. 1997) (Computer reservation system was prior art even though “essential algorithms of the SABRE software were proprietary and confidential and...those aspects of the system that were readily apparent to the public would not have been sufficient to enable one skilled in the art to duplicate the [unclaimed aspects of the] system.”). The extent that the public becomes “informed” of an invention involved in public use activity by one other than an applicant depends upon the factual circumstances surrounding the activity and how these comport with the policies underlying the on sale and public use bars. Manville Sales Corp. v. Paramount Sys., Inc., 917 F.2d 544, 549, 16 USPQ2d 1587, 1591 (Fed. Cir. 1990) (quoting King Instrument Corp. v. Otari Corp., 767 F.2d 833, 860, 226 USPQ 402, 406 (Fed. Cir. 1985)). By way of example, in an allegedly “secret” use by a third party other than an applicant, if a large number of employees of such a party, who are not under a promise of secrecy, are permitted unimpeded access to an invention, with affirmative steps by the party to educate other employees as to the nature of the invention, the public is “informed.” Chemithon Corp. v. Proctor & Gamble Co., 287 F. Supp. 291, 308, 159 USPQ 139, 154 (D.Md. 1968), aff’d., 427 F.2d 893, 165 USPQ 678 (4th Cir. 1970).

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It is noted with regard to claim 1 that someone must have selected the paint ingredients of the claim even if the inventors did not do the invention of claim 1 but only did the invention of claim 7.

7. Claims 1-11, 13-14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the declarants'/applicants' declarations of 5/19/06 which states that they, in their capacity as painters hired to paint the public buildings, as stated in their declarations, which were then subsequently leased to the public according to the declaration of Beverly A. Rahe, painted the walls of the declared public buildings and in doing so gave their invention to the public because, as a matter of law, the paint became the property of the public building upon its application to the premises and in view of the declaration of Jack D. Smith stating that certain aspects of the instantly claimed inventions are obvious and the applicant's implicit endorsement of these statements as evidenced by their submission of this declaration and the applicant's representative's statements regarding the obviousness of the remaining claims. Particular attention to paragraph 9 of the Oltman declaration has been given, which appears to be an admission that the instantly claimed inventions were used in public so as to create a statutory bar according to the above cited statute.

This rejection is made for the reasons stated in paragraph 6 above in combination with MPEP 2133, "It should be noted that 35 U.S.C. 102(b) may create a bar to patentability either alone, if the device in public use or placed on sale anticipates a later claimed invention, or in conjunction with 35 U.S.C. 103, if the claimed invention would have been obvious from the device in conjunction with the prior art. *LaBounty Mfg. v. United States Int 'l Trade Comm 'n*, 958 F.2d 1066, 1071, 22 USPQ2d 1025, 1028 (Fed. Cir. 1992)."

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8. Claims 1-11, 13-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6706107 Walker et al. with US Pat. Application Publication 2002/0129744 Immordino, Jr. cited as evidence.

This rejection is maintained as stated in paragraphs 4 and 13 of the office action of 11/22/05. In addition, the compositions of Walker contain the instantly claimed ingredients which must necessarily inherently make the scent "long-lasting" by some standard.

The newly submitted 131 declarations submitted by the applicant on 5/19/06 have been fully considered. They are not persuasive in swearing behind the above reference because they do not establish that the applicant performed the invention of Walker nor made it obvious prior to the effective filing date of Walker. The declarations state that in April 2001 the declared acts were performed but it is not seen that they were not done on April 5-31, e.g. it cannot be seen that they were done prior to Walker. Furthermore, the invention of the declarant is not that of Walker and the invention of Walker is not seen to be an obvious variant of the invention stated in the applicants' declarations. The Smith declaration is noted but does not address Walker's invention. Paragraph 6 is "opinion" and therefore not probative in addition. There is no evidence making the invention of Walker obvious in view of whatever was done in the applicants' declarations. It is clear that they added the stated deodorizer to some kind of paint but the specifics of the paint and the ingredients of the deodorizer are not stated and do not appear to be those of Walker. See MPEP 715, particularly 37 CFR 1.131. Affidavit or declaration of prior invention.

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of

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the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish

invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application

publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). Prior invention may

not be established under this section in any country other than the United States, a NAFTA country,

or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a

WTO member country other than a NAFTA country. Prior invention may not be established under this

section if either:

**>

(1) The rejection is based upon a U.S. patent or U.S. patent application publication of a pending or patented application to another or others which claims the same patentable invention as

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defined in § 41.203(a) of this title, in which case an applicant may suggest an interference pursuant to

§ 41.202(a) of this title; or<

(2) The rejection is based upon a statutory bar.

**>

(b) The showing of facts shall be such, in character and weight, as to establish reduction to

practice prior to the effective date of the reference, or conception of the invention prior to the

effective date of the reference coupled with due diligence from prior to said date to a subsequent

reduction to practice or to the filing of the application. Original exhibits of drawings or records, or

photocopies thereof, must accompany and form part of the affidavit or declaration or their absence

must be satisfactorily explained.<

It is not seen that the showing of facts is of sufficient character and weight to establish reduction to practice prior to the effective date of the reference for the reasons stated above. It is not seen that the applicants' explanation of why there is not such evidence is satisfactory. Everyone wants to keep their invention secret but they tend to keep lab notes in the examiner's experience. Furthermore, the declarations lack sufficient detail even lacking lab notes to

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constitute the required showing of facts. The claims of Walker are to the same invention as required above and therefore cannot be sworn behind.

For the above reasons, this rejection is maintained.

9. Claims 1, 7, 13-14, and 19-20 are rejected under 35 U.S.C. 102(a) as being anticipated by US Pat. No. 6583195 Sokol.

Sokol discloses combining polymerizable compound which appears to be both binder and vehicle, pigment, scenting agent, and non-reactive diluent which falls within the scope of solvent. The scenting agent may be citronella. See the entire reference, particularly column 2, lines 30-67; column 3, lines 10-34; column 6, lines 22-24; claims 1, 2, and 10 and the remainder of the document. Since the composition is that of the instant claims, the scent is expected to be "long-lasting" by some standard. The applicant's declarations do not swear behind the effective date of this reference and are additionally defective in doing so for the same reasons stated above regarding Walker.

10. Claims 1-11, 13-14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6706107 Walker et al. with US Pat. Application Publication 2002/0129744 Immordino, Jr. cited as evidence in view of each of US Pat. Publication No. 2003/0232901 Maleeny et al., US Pat. No. 6583195 Sokol, and US Pat. No. 5217378 Donovan.

This rejection is made regarding Walker for the reasons stated in the rejection of paragraph 8 above.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to mix the ingredients of Walker according to the instant claims because Walker states that the components therein can be mixed together in any suitable order at column 5, lines 12-20

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and the instantly claimed orders of mixing are therefore encompassed by Walker and would have been expected to give the compositions of Walker since mixing order is not seen to materially affect the properties of the compositions of Walker.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the paint of Walker with the scents of Maleeny because the high fragrance levels of Maleeny would have been expected in the coatings of Walker as taught throughout Maleeny, particularly the abstract and sections [0020], [0031], and [0032]-[0033] and the claims. The applicant's declarations are not persuasive in swearing behind Maleeny because there is not sufficient evidence that the applicant conceived the invention of the common scope of Maleeny and the instant claims prior to Maleeny because the applicant's declarations do not provide sufficient evidence of what they invented nor that this invention was that of Maleeny or a variant from which Maleeny's invention is obvious. Furthermore, Maleeny claims the same invention. See the MPEP sections cited in paragraph 8 above and the statements of deficiencies of these declarations cited therein. These apply to Maleeny equally.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use citronella in the invention of Walker because it is a well known scenting agent that people like and is known to repel insects and is taught for use in coatings by Sokol, column 6, lines 22-24 and would have been expected to contribute its scent and properties to the paint of Walker.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use scents corresponding to the colors of the paints of Walker so that blind people would know the color of the room they are in based on the teachings of Donovan which would

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lead one to expect that the blind person would be able to tell the color of the room by the scent for the same reasons explained by Donovan and this falls within the scope of the instant claims 22-23.

11. Claims 1-11, 13-14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Publication No. 2003/0232901 Maleeny et al. in view of each of US Pat. No. 5705560 Takarabe et al., US Pat. No. 6706107 Walker et al., US Pat. No. 6583195 Sokol, and US Pat. No. 5217378 Donovan.

Discussions of the applicants' 131 declarations from above apply to this rejection also.

Maleeny discloses a method of making a long lasting scented paint by adding a scent composition to any typical paint containing a pigment suspended in a liquid (page 5, section [0051]). Maleeny does not specify the instantly claimed paint components and mixing orders. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed paint components and the instantly claimed mixing orders because Takarabe shows the instantly claimed paint components to be common at column 10, lines 39-45, the scenting of these typical compositions is within the scope of the teachings of Maleeny and the paints of Takarabe would have been expected to function in Maleeny's inventions and Walker shows that the mixing orders of the paint components are within the ability of the ordinary skilled artisan to choose as desired and they are not expected to materially affect the paint at column 5, lines 12-20.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use citronella in the invention of Maleeny because it is a well known scenting agent that people like and is known to repel insects and is taught for use in coatings by Sokol, column

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6, lines 22-24 and would have been expected to contribute its scent and properties to the paint of Maleeny.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use scents corresponding to the colors of the paints of Maleeny so that blind people would know the color of the room they are in based on the teachings of Donovan which would lead one to expect that the blind person would be able to tell the color of the room by the scent for the same reasons explained by Donovan and this falls within the scope of the instant claims 22-23.

12. Claims 1-11, 13-14, 16-17, 19-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over The combination of US Pat. No. 5078792 Hinkle et al. and French Patent Publication No. 2807441 Haddad as translated by the supplied Derwent abstract in view of US Pat. No. 5705560 Takarabe et al., US Pat. No. 6583195 Sokol, and US Pat. No. 5217378 Donovan.

Each of Hinkle and Haddad disclose the scenting of paints but do not disclose the instantly claimed paint components nor the claimed mixing orders.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed paint components and the instantly claimed mixing orders in making the scented paints of either of Hinkle or Haddad because Takarabe shows the instantly claimed paint components to be common paint components at column 10, lines 39-45, the scenting of these typical compositions is within the scope of the teachings of Hinkle and Haddad and the paints of Takarabe would have been expected to function in Hinkle's and Haddad's

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inventions and the mixing orders of the paint components are within the ability of the ordinary skilled artisan to choose as desired and they are not expected to materially affect the paint.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use citronella in the invention of Hinkle or Haddad because it is a well known scenting agent that people like and is known to repel insects and is taught for use in coatings by Sokol, column 6, lines 22-24 and would have been expected to contribute its scent and properties to the paint of Hinkle or Haddad.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use scents corresponding to the colors of the paints of Hinkle or Haddad so that blind people would know the color of the room they are in based on the teachings of Donovan which would lead one to expect that the blind person would be able to tell the color of the room by the scent for the same reasons explained by Donovan and this falls within the scope of the instant claims 22-23.

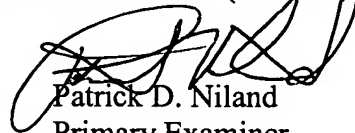
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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A handwritten signature in black ink, appearing to read 'P. Niland', is written over the printed name.

Patrick D. Niland
Primary Examiner
Art Unit 1714